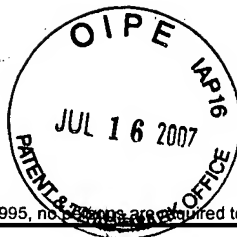


Doc Code: AP.PRE.REQ



PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

944-005.005

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on July 12, 2007

Signature

Typed or printed name

Margery B. Hood

Application Number

10/090,426

Filed

Feb. 28, 2002

First Named Inventor

L. Paatero

Art Unit

2132

Examiner

V. Herring

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒

attorney or agent of record.

Registration number 45,858☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

Signature

Andrew T. Hyman

Typed or printed name

(203) 261-1234

Telephone number

July 11, 2007

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE U.S. PATENT AND TRADEMARK OFFICE

Re application of

L. Paatero

Serial No. 10/090,426

Filed: February 28, 2002



Examiner: V. Herring

Supervisory Examiner: G. Barron

Group Art Unit: 2132

For: METHOD AND SYSTEM TO ALLOW PERFORMANCE OF
PERMITTED ACTIVITY WITH RESPECT TO A DEVICE

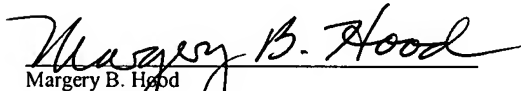
PRE-APPEAL BRIEF REQUEST FOR REVIEW: ARGUMENTS

Mail Stop AF
Commissioner for Patents
PO Box 1450
Alexandria VA 22313-1450

Sir:

In response to the final Office Action of 6 April 2007 and the Advisory Action of 29 June 2007, reconsideration of the rejections is respectfully requested in view of the following remarks that are being filed together with a Notice of Appeal (PTO/SB/31) and a Pre-Appeal Brief Request for Review (PTO/SB/33). These remarks comprise less than six pages total, as required by *USPTO OG Notice 12 July 2005*.

I hereby certify that this correspondence is being deposited today with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, PO Box 1450, Alexandria VA 22313-1450.


Margery B. Hood

Dated:



REMARKS

The Advisory Action (dated 29 June 2007) entered amendments that Applicant provided in the Response to Final (dated 7 June 2007), including cancellation of claim 46 and insertion of the limitations of claim 46 into claim 1. Now, claims 1-27, 35-43, 45, and 47-50 are pending.

The independent claims are method claim 1, mechanism claim 20, apparatus or system claim 26, method claim 41, and apparatus claim 49. All claims stand rejected as being anticipated under 35 U.S.C. 102(e) by *Doyle et al* (U.S. Pat. No. 6,968,453).

Please observe that claim 46 was rejected at page 16 of the Final Office Action (last full paragraph), in reliance upon column 11, line 18 of *Doyle*, which at column 8, lines 5-15 incorporates *Hind*. Applicant respectfully submits that the *Doyle* reference does not validly incorporate *Hind* for purposes of anticipating present claim 46 (which was inserted into claim 1 after final).

The purported incorporation by reference of *Hind* occurs at column 8, lines 5-15 of *Doyle*, but **Doyle never directs attention to any specific portions of *Hind* that are relied upon by the final Office Action to reject Applicant's claim 46 (which is now inserted into claim 1).** As the Federal Circuit explained in *Advanced Display v. Kent State*, 54 USPQ2d 1673, 1679 (Fed. Cir. 2000) (emphasis added):

Material not explicitly contained in the single, prior art document may still be considered for purposes of anticipation if that material is incorporated by reference into the document....To incorporate material by reference, the host document must identify with ***detailed particularity what specific material*** it incorporates and clearly indicate where that material is found in the various documents. (emphasis added)

The final Office Action states at page two that the Examiner is no longer relying upon *Hind* (U.S. Patent No. 6,976,163). However, the final Office Action repeatedly relies upon column 11, line 18 of *Doyle*, which at column 8, lines 5-15 purports to incorporate *Hind*. See especially page 16 of the final Office Action, at the end of the last full paragraph ("note column 11, line 18"). The **only** ground in the final Office Action

for rejecting claim 46 (which has been inserted into claim 1 after final), is the *Hind* reference.

Applicant therefore respectfully submits that a 102(e) rejection is inappropriate here. The *Doyle* reference does not validly incorporate the *Hind* reference, for purposes of this anticipation rejection under 35 U.S.C. § 102(e), for the reasons explained in *Advanced Display v. Kent State* (quoted above).

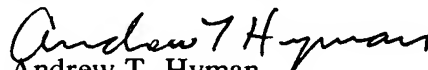
The Advisory Action states that Applicant's argument about the validity of the incorporation by reference "does not address the rejections of the independent claims." However, that is incorrect, because the limitations of claim 46 have been inserted into independent claim 1 after final, and the Advisory Action entered that amendment.

Applicant respectfully emphasizes that neither the final Office Action nor the Advisory Action cited any portion of *Doyle* to reject the limitations of claim 46 (now in claim 1), other than *Doyle*'s invalid incorporation of *Hind*. Without *Hind*, *Doyle* does not teach or suggest the limitations of claim 46 (now in claim 1), nor has the USPTO pointed to anything in *Doyle* that does so.

CONCLUSION

Because the cited *Doyle* reference does not teach or suggest critical elements of the present independent claims, it is respectfully submitted that those claims are novel and patentable. Thus, allowance of the pending claims is respectfully requested.

Respectfully submitted,


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July 11, 2007
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